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10/661,279

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EXAMINER

LEE, PHILIP C

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|----------------------------------|--|
| Office Action Summary | Application No. 10/661,279 | Applicant(s) LO ET AL. | |
| | Examiner Philip C. Lee | Art Unit 2152 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>12/8/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-23 are presented for examination.

Objections

2. Claims 1-21 are objected to because of the following informalities or grammar errors: As per claims 1 (line 4), 3 (lines 2-3), 5 (lines 2-3), 10 (line 4), 13 (lines 2 and 3), 15 (line 5), 17 (lines 3-4), 18 (line 5) and 21 (lines 3 and 4), “the selected instant message client” should be “at least the selected one of a plurality of potential instant message clients”.
3. Claims 15-21 are objected to because according to MPEP 608.01, antecedent basis for the terms appearing in the claims, while an applicant is not limited to the nomenclature used in the application as filed, he or she should make appropriate amendment of the specification whenever this nomenclature is departed from by amendment of the claims so as to have clear support or antecedent basis in the specification for the new terms appearing in the claims. Applicant will be required to make appropriate amendment to the description to provide clear support or antecedent basis for the terms appearing in the claims provided no new matter is introduced. The term “machine-accessible media” is lacking clear support or antecedent basis in the description of the specification.

Claim Rejections – 35 USC 112

4. Claims 15-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim language in the following claims is not clearly understood:

i. As per claim 15, line 2, it is unclear if “data” refers to “data” in line 1 [if they are the same, then terms such as “the” or “said” should be used; if they not the same, then terms such as “associated instructions” may be used if it is supported by the specification).

ii. As per claim 15, line 3, it is unclear if “the data” refers to “data” in line 2 or “data” in line 1 (does “the data” in line 3 meant *the instructions*?).

iii. As per claim 18, line 2, it is unclear if “data” refers to “data” in line 1 [if they are the same, then terms such as “the” or “said” should be used).

iv. As per claim 18, line 3, it is unclear if “the data” refers to “data” in line 2 or “data” in line 1.

Claim Rejections – 35 USC 101

5. Claims 15-21 are rejected under 35 U.S.C. 101 because “An article (i.e., is it an article of manufacture?) comprising a machine-accessible media having associated data...” does not provide functional description language, it is considered as Non-Functional Descriptive Material.

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Non-functional descriptive material *per se* is not statutory. Even when non-functional descriptive material is stored to be read or outputted by a computer without any functional interrelationship, they do not impart functionality to the computer (i.e., they are not computer components).

Claim Rejections - 35 USC 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claim 22 is rejected under 35 U.S.C. 102(e) as being anticipated by Greene, U.S. Patent 6,668,173 (hereinafter Greene).

7. As per claim 22, Greene teaches the invention substantially as claimed comprising: an instant messaging server (col. 3, lines 12-15); a first instant messaging client communicatively coupled with the instant messaging server (col. 3, lines 9-12), wherein the first instant messaging client is configured to provide a first location for the first instant messaging client to the instant messaging server (col. 4, lines 29-39) (one of the plurality of wireless device 13 transmitting position data to the IM server); a second instant messaging client communicatively coupled with the first instant messaging client and the instant messaging server (col. 3, lines 9-12), wherein the second instant messaging client is configured to provide a second location for the second instant messaging client to the instant messaging server (col. 4, lines 29-39) (another one of the plurality of wireless device 13 transmitting position data to the IM server).

Claim Rejections – 35 USC 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 3-7, 10, 13-15, 17-18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yu et al, U.S. Patent 7,058,036 (hereinafter Yu) in view of Greene.

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10. As per claims 1 and 15, Yu teaches the invention substantially as claimed for distributing data to at least a selected one of a plurality of potential instant message clients (abstract), comprising: transmitting an identifier of a first client to an instant messaging server (col. 2, lines 25-36) (client providing instant message ID comprising the terminal's IP address to the IM server) coordinating communication with at least the selected instant message client (col. 2, lines 42-56).

11. Yu does not teach determining and transmitting client location to the instant message server. Greene teaches a similar invention comprising: determining a first location for the first client (col. 2, lines 9-10; col. 3, lines 48-50) (GPS receiver receives signals and determines the position of the wireless device 13); and transmitting the first location for the first client to the instant messaging server (col. 2, lines 25-26; col. 4, lines 13-14)(wireless device 13 send position data to the IM server 19).

12. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Yu and Greene because Greene's teaching of determining and transmitting client location would increase the efficiency of Yu's system by providing status and location information of users instantaneously and automatically without the user having to provide updates of his current status or location.

13. As per claims 3 and 17, Yu and Greene teach the invention substantially as claimed in claims 1 and 15 above. Greene further teach receiving from the instant messaging server a

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second location for the selected instant messaging client (col. 4, lines 13-20) (other devices 11, 13 receiving position change data for the wireless device 13).

14. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Yu and Greene for the same reason set forth in claim 1 above.

15. As per claim 4, Yu and Greene teach the invention substantially as claimed in claim 3 above. Greene further teach selecting an application program for execution based at least in part on the second location col. 4, lines 13-20; col. 2, lines 25-29) (selecting position-to-location tag translation application based on position change data).

16. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Yu and Greene for the same reason set forth in claim 1 above.

17. As per claim 5, Yu and Greene teach the invention substantially as claimed in claim 3 above. Greene further teach comprising: displaying an initial icon indicating an initial status of the selected instant messaging client (col. 1, lines 23-27); and displaying a revised icon corresponding to the second location (col. 1, lines 28-32).

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18. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Yu and Greene for the same reason set forth in claim 1 above.

19. As per claim 6, Yu and Greene teach the invention substantially as claimed in claim 5 above. Greene further teach wherein the initial icon is a selected one of: an offline indicator, an online indicator, and an emoticon (col. 1, lines 26-27).

20. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Yu and Greene for the same reason set forth in claim 1 above.

21. As per claim 7, Yu and Greene teach the invention substantially as claimed in claim 5 above. Greene further wherein the revised icon is a selected one of: a country identifier, a state identifier, a government seal, a flag, a building identifier, and a user identifier (col. 4, line 47-col. 5, line 14).

22. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Yu and Greene for the same reason set forth in claim 1 above.

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23. As per claims 10 and 18, Yu teaches the invention substantially as claimed for distributing data to at least a selected one of a plurality of potential instant message clients (abstract), comprising: receiving an identifier of a first client by an instant messaging server (col. 2, lines 25-36)(IM server receiving instant message ID comprising the terminal's IP address from the client) coordinating communication with at least the selected instant message client (col. 2, lines 42-56).

24. Yu does not teach receiving client location. Greene teaches a similar invention comprising: receiving a first location for the first client (col. 2, lines 25-26; col. 4, lines 13-14)(wireless device 13 send position data to the IM server 19).

25. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Yu and Greene because Greene's teaching of receiving client location would increase the efficiency of Yu's system by allowing status and location information of users to be instantaneously and automatically received without the user having to provide updates of his current status or location.

26. As per claims 13 and 21, Yu and Greene teach the invention substantially as claimed in claims 10 and 18 above. Greene further receiving from the selected instant message client a second location for the selected instant messaging client (col. 1, lines 28-32; col. 4, lines 13-20).

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27. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Yu and Greene for the same reason set forth in claim 10 above.

28. As per claim 14, Yu and Greene teach the invention substantially as claimed in claim 13 above. Greene further transmitting the second location to the first client (col. 4, lines 13-20).

29. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Yu and Greene for the same reason set forth in claim 10 above.

30. Claims 2, 11-12, 16 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yu and Greene in view of O'Neil, U.S. Patent Application Publication 2002/0107027 (hereinafter O'Neil).

31. As per claims 2 and 16, Yu and Greene teach the invention substantially as claimed in claims 1 and 15 above. Yu and Greene do not teach receiving advertisement responsive to location. O'Neil teaches receiving an advertisement from a server responsive to transmitting the first location ([0004], [0027]-[0029]).

32. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Yu, Greene and O'Neil because O'Neil's

teaching of receiving advertisement responsive to location would increase the functionality of Yu's and Greene's systems by providing targeted content such as advertisement to users based on location information such as timing information, consumer demographics, specific consumer instructions or any other information that will increase the likelihood of a successful match ([0028]).

33. As per claims 11 and 19, Yu and Greene teach the invention substantially as claimed in claims 10 and 18 above. Yu and Greene do not teach transmitting advertisement responsive to location. O'Neil teaches transmitting an advertisement to the first client responsive to receiving the first location ([0027]-[0029]).

34. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Yu, Greene and O'Neil because O'Neil's teaching of transmitting advertisement responsive to location would increase the functionality of Yu's and Greene's systems by providing targeted content such as advertisement to users based on location information such as timing information, consumer demographics, specific consumer instructions or any other information that will increase the likelihood of a successful match ([0028]).

35. As per claims 12 and 20, Yu and Greene teach the invention substantially as claimed in claims 10 and 18 above. Yu and Greene do not teach transmitting advertisement responsive to location. O'Neil teaches comprising: transmitting the first location to an advertisement server

([0027], [0041]); receiving an advertisement from the advertisement server, the advertisement determined based at least in part on the first location ([0028], [0043], [0048]); and transmitting the advertisement to the first client ([0029]).

36. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Yu, Greene and O'Neil because O'Neil's teaching of transmitting advertisement responsive to location would increase the functionality of Yu's and Greene's systems by providing targeted content such as advertisement to users based on location information such as timing information, consumer demographics, specific consumer instructions or any other information that will increase the likelihood of a successful match ([0028]).

37. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yu and Greene in view of Mayer, U.S. Patent Application Publication 2004/0122810 (hereinafter Mayer).

38. As per claim 8, Yu and Greene teach the invention substantially as claimed in claim 3 above. Yu and Greene do not teach a map identifying the relative position of the locations. Mayer teaches a proximity map including a marker identifying the relative position of the second location to the first location when the second location is proximate to the first location ([0073]).

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39. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Yu, Greene and Mayer because Mayer's teaching of a proximity map would increase the user alertness in Yu's and Greene's systems by providing a geographical information such as a map in order to let a user know more exactly the locations of other users.

40. As per claim 9, Yu, Greene and Mayer teach the invention substantially as claimed in claim 8 above. Greene further wherein the marker is a selected one of: a country identifier, a state identifier, a government seal, a flag, a building identifier, and a user identifier (col. 4, line 47-col. 5, line 14).

41. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Greene in view of Tsou et al, U.S. Patent Application Publication 2002/0184089 (hereinafter Tsou) and further in view of O'Neil.

42. As per claim 23, Greene teaches the invention as claimed in claim 22 above. Greene does not teach an advertisement server. Tsou teaches an advertisement server communicatively coupled with at least the instant messaging server (fig. 3).

43. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Greene and Tsou because Tsou teaching of an

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advertisement server would enhance Greene's instant messaging system by allowing advertising and network marketing of business to instant messaging users.

44. Greene and Tsou do not teach receiving advertisement responsive to location. O'Neil teaches wherein the advertisement server is configured to provide an advertisement determined based at least in part on client locations provided to the advertisement server by a server ([0004], [0027]-[0029]).

45. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Greene, Tsou and O'Neil because O'Neil's teaching of receiving advertisement responsive to location would increase the functionality of Greene's and Tsou's systems by providing targeted content such as advertisement to users based on location information such as timing information, consumer demographics, specific consumer instructions or any other information that will increase the likelihood of a successful match ([0028]).

CONCLUSION

46. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

De Vries, US 6,968,179; Coskun et al, US 2006/0142030; Briggs et al, US 7,080,139; Deshpande, US 2003/0046273; Knauerhase et al, US 2004/0203746.

47. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Lee whose telephone number is (571)272-3967. The examiner can normally be reached on 8 AM TO 5:30 PM Monday to Thursday and every other Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

P.L.

A handwritten signature in black ink, appearing to read "Philip C Lee", written in a cursive style.